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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,590	11/12/2003	Kazunari Tokuda	17205	7830
23389	7590	05/12/2006	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/706,590	Applicant(s) TOKUDA ET AL.	
	Examiner John P. Leubecker	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/12/03</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election of Group II, claims 10-16 in the reply filed on March 9, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 10-12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitsui (U.S. Pat. 3,889,662).

Referring mainly to Figures 6 and 7, Mitsui discloses an endoscope comprising an inserting portion (at least 11 and 12), an illuminating means (23), a normal observing optical system (19), a confocal optical system (amplifying lenses 20) and a waveform split element

Art Unit: 3739

(27,28) which is shared by both optical systems. Integrally formed to the waveform split element are concave lens surface (note surfaces of lenses 19) and a diffraction-type optical device (either 29 or 26).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsui in view of Togino (U.S. Pat. 6,147,808).

Mitsui fails to disclose concave or convex surfaces, whether mirrored or not, within the waveform split element. However, it is known in the optics art to combine curved (convex and concave) mirrored and refractive surfaces in a prism system (as opposed to separate lens elements and mirrored surfaces) to reduce size, number of components, weight and cost (Togino, col.1, lines 14-18, col.2, lines 57-60, col.3, lines 9-27 and exemplified in at least Figures 15, 16b and 17). Therefore, assuming that the objective lens systems 18 and 20 are only representatively shown, and that these systems would inherently include concave and convex surfaces (the mirrored surface is at 27), it would have been obvious to one of ordinary skill in the art to have provided such surfaces in the most compact and efficient way possible, as taught by Togino.

Art Unit: 3739

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsui in view of Krauter (U.S. Pat. 5,140,975).

Mitsui discloses a light guide bundle (23) as an illumination means and a light guide bundle (17) for the image transmission means. Thus, Mitsui fails to disclose a solid state image pick-up device. Although the Examiner takes the position that this is ordinarily known and conventional, Krauter is cited (as one of many references that could be cited) to evidence that using a solid state image pick-up device instead of the optical fiber bundle of Mitsui to transmit the image back to a viewer has been contemplated and is conventionally known. It would have been obvious to one of ordinary skill in this art to have replaced the optical fiber bundle of Mitsui with a solid state image pick-up device for all of the known reasons: produce a video image for display on a monitor, eliminate need for fragile and bulky optical fibers, greater resolution, etc.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaneko et al. (U.S. Pat. 5,305,759)

Tanaka (U.S. Pat. 6,930,705)

Farkas et al. (U.S. Pat. 6,530,882)

Mizuno (US 2004/0122289)

Harris (US 2005/0228229)

Tokuda et al. (US 2003/0233028)

Dickensheets et al. (U.S. Pat. 5,742,419)

Penn (US 2006/0061892)

Suga (US 2002/0018276)

Xie et al. (U.S. Pat. 6,809,866)

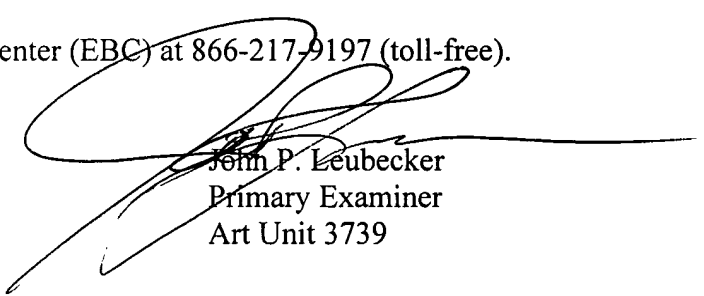
Art Unit: 3739

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769.

The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl